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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,772	01/25/2001	Roger Edwards	C005	5011

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PATENT DEPARTMENT
MACROVISION CORPORATION
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SANTA CLARA, CA 95050

EXAMINER

MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/744,772	EDWARDS, ROGER	
	Examiner	Art Unit	
	Aravind K Moorthy	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 10-14, 18, 19, 21, 25, 26 and 30-38 is/are rejected.
- 7) ☒ Claim(s) 4-6, 9, 15-17, 20, 22-24 and 27-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-38 are pending in the application.
2. Claims 1-3, 7, 8, 10-14, 18, 19, 21, 25, 26 and 30-38 have been rejected.
3. Claims 4-6, 9, 15-17, 20, 22-24 and 27-29 have been objected to as being dependent upon a rejected claim.

EXAMINER'S AMENDMENT

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Norman Klivans on 11/19/04.

The application has been amended as follows:

Claim 1 (amended) A method of copy protecting a digital audio compact disc carrying audio data and control data, wherein the control data is encoded onto the compact disc, the copy protection method comprising rendering selected control data incorrect, said selected control data being ignored by an audio player, such that an audio player is able to play the audio data, whereas the incorrect data negatively effects the playability of the audio data in a data reader which is enabled to read data and process information from each sector of the compact disc.

Claim 8 (amended) A method of copy protecting a digital audio compact disc carrying audio data and control data, wherein the control data is encoded onto the compact disc, the copy protection method comprising rendering selected control data incorrect, said selected control data

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being ignored by an audio player, such than an audio player is able to play the audio data, whereas the incorrect data negatively effects the playability of the audio data in a data reader which is enabled to read data and process information from each sector of the compact disc, and wherein control data encoded on the compact disc defining the nature of the tracks is also rendered incorrect.

Claim 12 (amended) A copy protected digital audio compact disc carrying audio data and control data, wherein the control data is encoded onto the compact disc, and wherein selected control data has been rendered incorrect, said selected control data being ignored by an audio player, such than an audio player is able to play the audio data, whereas the incorrect data negatively effects the playability of the audio data in a data reader which is enabled to read data and process information from each sector of the compact disc.

Claim 19 (amended A copy protected digital audio compact disc carrying audio data and control data, wherein the control data is encoded onto the compact disc, and wherein selected control data has been rendered incorrect, said selected control data being ignored by an audio player, such than an audio player is able to play the audio data, whereas the incorrect data negatively effects the playability of the audio data in a data reader which is enabled to read data and process information from each sector of the compact disc, and wherein control data encoded on the compact disc defining the nature of the tracks is also rendered incorrect.

Response to Arguments

5. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-38 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: how the rendered incorrect control data accomplishes copy protecting a digital audio compact disc carrying audio data.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 2, 7, 8, 11-13, 18, 19, 26 and 31-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Stebbings U.S. Patent No. 6,684,199 B1.

As to claims 1 and 12, Stebbings discloses a method of copy protecting a digital audio compact disc carrying audio data and control data [column 19, lines 38-46]. Stebbings discloses that the control data is encoded onto the compact disc [column 19, lines 38-46]. Stebbings discloses the copy protection method comprising rendering selected control data incorrect [column 19, lines 38-46]. Stebbings discloses that the selected control data being ignored by an audio player, such that an audio player is able to play the audio data [column 19, lines 3-11], whereas the incorrect data negatively effects the playability of the audio data in a data reader which is enabled to read data and process information from each sector of the compact disc [column 19, lines 3-11].

As to claims 2 and 13, Stebbings discloses that the control data encoded on the compact disc that has been rendered incorrect is navigation data [column 20, lines 1-8].

As to claims 7 and 18, Stebbings discloses that the control data encoded on the compact disc defining the nature of the tracks is rendered incorrect [column 20, lines 1-8].

As to claims 8 and 19, Stebbings discloses a method of copy protecting a digital audio compact disc carrying audio data and control data, as discussed above. Stebbings discloses that the control data is encoded onto the compact disc, as discussed above. Stebbings discloses the copy protection method comprising rendering selected control data incorrect, as discussed above. Stebbings discloses the selected control data being ignored by an audio player, such that an audio player is able to play the audio data, whereas the incorrect data negatively effects the playability of the audio data in a data reader which is enabled to read data and process information from each sector of the compact disc, as discussed above. Stebbings discloses that

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the control data encoded on the compact disc defining the nature of the tracks is also rendered incorrect [column 20, lines 1-8].

As to claims 11 and 26, Stebbings discloses that the control data encoded on the compact disc is altered, to render it incorrect, prior to mastering of the disc [column 19, lines 38-46].

As to claims 31, 33, 35 and 37, Stebbings discloses that the incorrect control data negatively effects the playability of the audio data in a conventional data reader [column 21, lines 55-63].

As to claims 32, 34, 36 and 38, Stebbings discloses that the data reader cannot play any of the audio data carried on the compact disc [column 21, lines 55-63].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 10, 14, 21, 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stebbings U.S. Patent No. 6,684,199 B1 as applied to claims 1, 8, 12 and 19 above, and further in view of Maeda et al U.S. Patent No. 5,153,861.

As to claims 3, 10, 14, 21, 25 and 30, Stebbings discloses that the data is rendered incorrect, as discussed above.

Stebbing does not teach that the data is provided in the lead-in and identifies the position on the disc of the lead-out.

Maeda's invention teaches a recording/reproducing device where additional information concerning reproducing procedures, etc. edited by the user is recorded in the lead-in region on a recording medium [column 2 line 40-49]. The TOC (table of contents) is formed in the lead-in region [column 4 lines 10-14]. The TOC contents contains the start and end position of each track.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Stebbings so that lead-in region would contain the invalid symbols and would identify the position of the lead-out. The examiner asserts that the end of the last track is going identify the position of the lead-out.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Stebbings by the teaching of Maeda because it saves the user the conventional trouble of entering procedures for reproduction, etc. every time he/she places the recording medium in the recording/reproducing device, thereby resulting in an enhanced operability, column 3 lines 33-43.

Allowable Subject Matter

9. Claims 4-6, 9, 15-17, 20, 22-24 and 27-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to claims 4 and 15, prior art does not disclose, teach or suggest that the control data in the Lead-In that indicates the Atime at the start of the Lead-Out is rendered incorrect.

As to claims 5 and 16, prior art does not disclose, teach or suggest that the control data in the Lead-in shows the Atime at the start of the Lead-Out to be zero.

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As to claims 6 and 17, prior art does not disclose, teach or suggest that the control data in the Lead-In has a value for the Atime at the start of the Lead-Out that occurs during a first audio track on the compact disc.

As to claims 9, 20, 24 and 29, prior art does not disclose, teach or suggest that the data on the CD identifying the nature of the tracks incorrectly identifies each audio track as a data track.

As to claims 22 and 27, prior art does not disclose, teach or suggest that the control data encoded on the compact disc that has been rendered incorrect is timing data.

As to claims 23 and 28, prior art does not disclose, teach or suggest that the control data encoded on the compact disc that has been rendered incorrect is navigation and timing data.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system; see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy
December 8, 2004

E. L. Moise
EMMANUEL L. MOISE
PRIMARY EXAMINER
A/U 2136